

### **REMARKS**

An Office Action was issued in the subject application on July 13, 2004, in which:

- (1) the specification was objected to;
- (2) claims 1–13 and 18 were objected to;
- (3) claims 15–17 and 30 were rejected under 35 U.S.C. § 112;
- (4) claims 19, 20, and 22–26 were rejected under 35 U.S.C. § 102;
- (5) claims 14–22, 25, 27, and 30 were rejected under 35 U.S.C. § 103; and
- (6) claims 1–13, 28, and 29 were deemed allowable.

Each of the objections and rejections is addressed hereunder in the order presented in the Office Action.

Summarizing this Amendment, claims 1, 7, 15–19, and 30 have been amended to more particularly claim and distinctly point out the subject matter which applicant regards as the invention. Claims 1–30 remain in the application.

Reconsideration and reexamination of the subject application in view of the amendments and the following remarks are respectfully requested.

### **OBJECTIONS TO THE SPECIFICATION**

The specification has been objected to for a number of informalities. The Examiner is thanked for carefully reviewing the specification and catching these typographical errors highlighted in the Office Action.

Paragraphs 0021, 0028, and 0030 of the specification have been amended accordingly. It is respectfully submitted that the typographical errors have been corrected.

### **OBJECTIONS TO THE CLAIMS**

Claims 1–13 and 18 have been objected to for a number of informalities. The Examiner is again thanked for carefully reviewing the claims and catching the typographical errors outlined in the Office Action.

Claims 1, 7, and 18 have been amended as suggested by the Examiner. It is respectfully submitted that the typographical errors have been corrected.

### **REJECTIONS UNDER 35 U.S.C. § 112**

Claims 15–17 and 30 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 15–17 and 30 have been amended as suggested by the Examiner by adding the element performing the “positionable” function. Support for the amendments may be found at, for example, in paragraphs 0027, 0028, and 0029 and in FIGS. 5, 8, and 9.

It is respectfully submitted that the claims 15–17 and 30 as amended accord 35 U.S.C. § 112 and render these rejections moot.

### **REJECTIONS UNDER 35 U.S.C. § 102**

Claims 19, 20, and 22–26 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 3,897,141 to Schocket.

Claims 19 and 22–24 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 3,729,627 to Littell.

Claim 19 has been amended to more distinctly claim and particularly point out the subject matter which applicant regards as the invention. Support for the amendment may be found at, for example, paragraph 0029 and FIG. 5.

Applicant traverses these rejections.

#### **Requirements for Anticipation**

The Federal Circuit stated in *W.L. Gore & Associates v. Garlock, Inc.* [721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983)] that an anticipation rejection under 35 U.S.C. § 102 “requires the disclosure of a single prior art reference of each element of the claim under consideration.” It is not enough, however, that the prior art reference disclose all the claimed elements in isolation. Rather, as stated by the Federal Circuit, “[a]nticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim” [*Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984)]. Likewise, the Court of Customs and Patent Appeals (CCPA) stated in *In re Wilder* [429 F.2d 447, 166 USPQ 545, 548 (C.C.P.A. 1976)]:

Simply stated, a prior publication or patent description will be considered as anticipatory when its disclosure is at once specific

and enabling with regard to the particular subject matter at issue. In effect, a prima facie case is made out whenever a reference is shown to contain a disclosure which is specific as to every critical element of the appealed claims.

In other words, a prima facie case of anticipation is established when the Patent Office provides:

- a) a single reference
- b) that teaches or enables
- c) each of the claimed elements (arranged as in the claim)
- d) expressly or inherently
- e) as interpreted by one of ordinary skill in the art.

If any one of these elements is not present, the prima facie case of anticipation is not established. In the instant case, it is respectfully submitted that the Schocket and Littell patents fail to meet these requirements.

### **The Cited References**

#### **U.S. Patent No. 3,897,141 to Schocket**

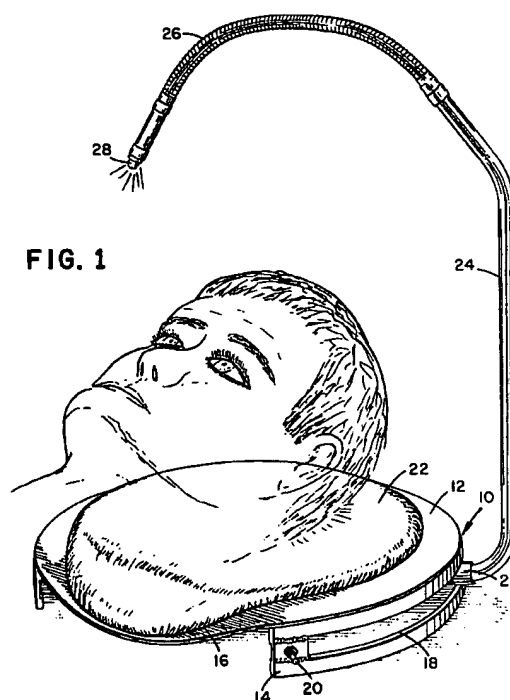
U.S. Patent No. 3,897,141 to Schocket shows an ophthalmic fixation device with a base 10 on which a patient rests his head.

An on-off switch 20 is fixed to the base 10.

An arm 24 with a flexible cable 26 is slidably received in a groove 18 formed in the base 10 by a sleeve 23. A light 28 is at the free end of the flexible cable 26.

Accordingly, the arm 24 can be rotated about the base 10, and the light 28 can be moved about as desired. (See column 2, line 59, to column 3, line 21, and FIG. 1.)

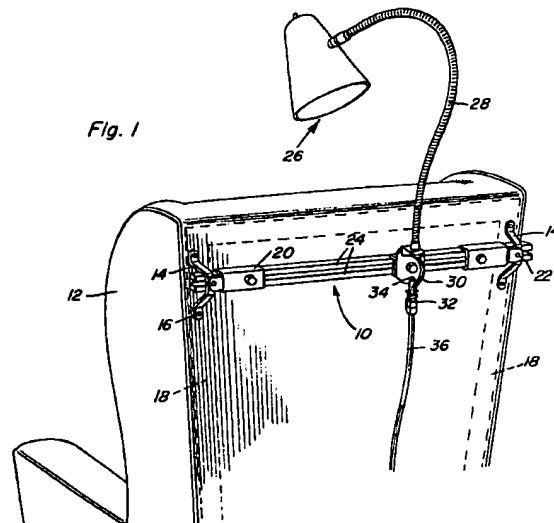
Accordingly, Schocket shows a device for hold a patient's head in place with a light that can be positioned for eye exams.



U.S. Patent No. 3,729,627 to Littell

U.S. Patent No. 3,729,627 to Littell shows an adjustable lamp assembly 10 that is adapted to be mounted to the back of a chair 12 by straps 14 and mounting bars 24. A lamp fixture 26 is mounted on a flexible neck 28 which, in turn, is mounted to an assembly 34 that may be moved along the mounting bars 24. (See column 1, line 62, to column 2, line 27, and FIG. 1.)

Accordingly, the Littell patent shows a light fixture that can be positioned as desired on a chair.



**The Present Invention**

Claim 19 recites a signal light for a chair including:

- a light housing;
- a support on which the light housing is disposed ... mounted to the chair ... ; and
- a switch housing ... that ... is spatially separated the light housing ... [and] including a connecting structure that is configured to enable the switch housing to be positionable with respect to the chair.

Claims 20 and 22–26 depending from claim 19 and respectively recite additional features of the signal light.

**Discussion**

In view of Schocket

In contrast to the signal light for a chair as recited in claim 19, Schocket shows a head rest for a patient with a light that may be positioned for an eye exam. Schocket fails to teach or suggest a support that is mounted to a chair. Rather, Schocket has an arm slidably received in a groove on a base.

In addition, Schocket fails to teach or suggest a switch housing that is positionable with respect to a chair. Rather, Schocket's switch is fixed to the base of the head rest.

Accordingly, it is respectfully submitted that the Schocket patent fails to teach or enable each of the claimed elements as arranged in independent claim 19, either expressly or inherently, as interpreted by one of ordinary skill in the art. Accordingly, it is respectfully submitted that the Schocket patent does not anticipate claim 19 and, therefore, that claim 19, as well as claims 20 and 22–26 respectively depending therefrom, are patentable

In view of Littell

In contrast to the signal light for a chair as recited in claim 19, Schocket shows a conventional lamp fixture (26) is attached to a chair in an adjustable manner. Littell fails to teach or suggest a switch housing that is spatially separated from a light housing as recited in claim 19. Rather, Little has a switch attached to or as part of the lamp fixture, as is typically with conventional devices. In addition, Littell fails to teach or suggest a switch housing that includes a connecting structure that enables the switch housing to be positionable with respect to a chair.

Accordingly, it is respectfully submitted that the Littell patent fails to teach or enable each of the claimed elements as arranged in independent claim 19, either expressly or inherently, as interpreted by one of ordinary skill in the art. Accordingly, it is respectfully submitted that the Littell patent does not anticipate claim 19 and, therefore, that claim 19, as well as claims 22–24 respectively depending therefrom, are patentable

**REJECTIONS UNDER 35 U.S.C. § 103**

Claims 14–16 and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 3,897,141 to Schocket in view of U.S. Patent No. 1,955,916 to Irminger.

Claim 17 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 3,897,141 to Schocket in view of U.S. Patent No. 1,955,916 to Irminger, and further in view of U.S. Patent No. 4,233,649 to Sheer et al.

Claims 19, 20, and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 2,744,997 to Sefcik et al. in view of U.S. Patent No. 1,704,415 to Wenegrat.

Claim 21 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 3,897,141 to Schocket in view of U.S. Patent No. 1,955,916 to Irminger.

Claims 25–27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 3,729,627 to Littell.

Claim 19 has been amended, as discussed above. Applicant traverses these rejections.

#### Requirements for Obviousness

The Federal Circuit stated in *In re Oeticker* [977 F.2d 1443, 24 USPQ 2d 1443 (Fed. Cir. 1992)], “[i]f examination at the initial stage does not produce a prima facie case of unpatentability, then without more the applicant is entitled to grant of the patent.” The CCPA interpreted prima facie obviousness in *In re Lintner* [458 F.2d 1013, 173 USPQ 560, 562 (C.C.P.A. 1972)] as follows:

In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed substitution, combination or other modification.

In *In re Rinehart* [531 F.2d 1048, 189 USPQ 143 147 (C.C.P.A. 1976)], the CCPA added that the prima facie case requires that the teachings of the reference “appear to have suggested the *claimed subject matter*.” In view of these decisions, a prima facie case of obviousness is established when the Patent Office provides:

- a) one or more references
- b) that were available to the inventor and
- c) that teach
- d) a suggestion to combine or modify the references,
- e) the combination or modification of which would appear to be sufficient to have made the claimed invention obvious to one of ordinary skill in the art.

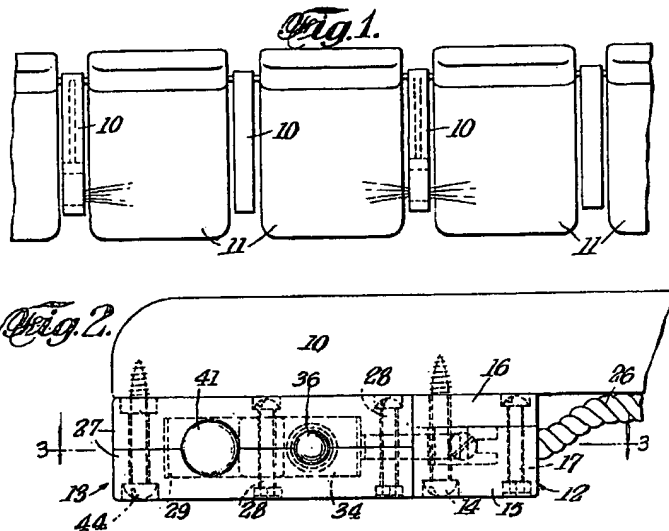
If any one of these elements is not present, the prima facie case of obviousness is not established. In the instant case, it is respectfully submitted that the cited references, either alone or in any combination, fail to meet these requirements.

#### The Cited References

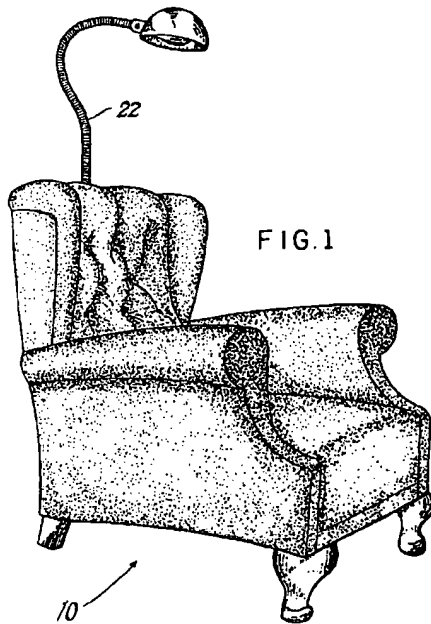
U.S. Patent No. 3,897,141 to Schocket and U.S. Patent No. 3,729,627 to Littell are discussed above.

U.S. Patent No. 1,955,916 to Irminger

U.S. Patent No. 1,955,916 to Irminger shows a theater chair 11 with a light formed in an arm rest 10. The light has a terminal portion 12 and a lamp portion 13. A lamp with a glass cover 41 face outward for program lighting, and a button 36 is mounted adjacent to the lamp/glass cover 41. (See lines 45–56, lines 64–78, and FIGS. 1 and 2.)



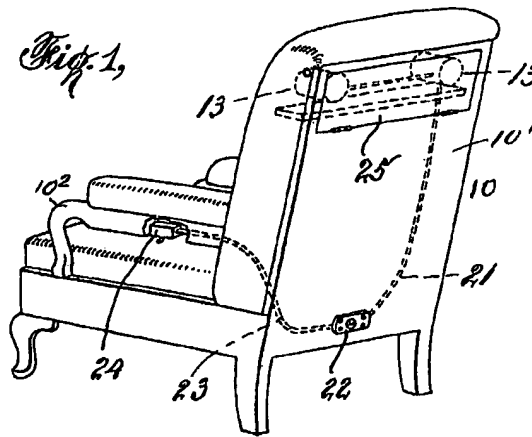
U.S. Patent No. 2,744,997 to Sefcik et al.



U.S. Patent No. 2,744,997 to Sefcik et al. shows an easy chair with an integrated lamp. The lamp has a flexible cable 22 which has a socket for a light bulb and a shade. Although not specifically called out in the specification or the drawings, it is assumed that the switch for the lamp is located where the cable 22 is connected to the shade element, which is state of the art for this type of lamp in 1953, which is the filing date of the Sefcik et al. patent. (See column 2, lines 9–11, and FIG. 1.)

U.S. Patent No. 1,704,415 to Wenegrat

U.S. Patent No. 1,704,415 to Wenegrat shows a chair 10 with lamps including supports 13 for the lamps and a hand switch 24 provided on one of the arms of the chair. (See lines 30-43, lines 74-77, and FIG. 1.)



U.S. Patent No. 4,233,649 to Sheer et al.

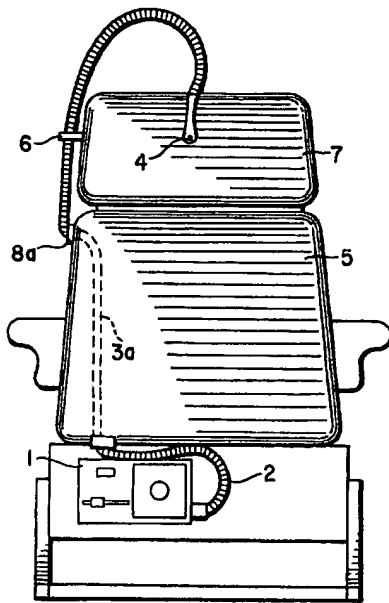


FIG. 1

U.S. Patent No. 4,233,649 to Sheer et al. shows a dental chair with a switch box 1 with a power supply that is mounted to a chair. A flexible tubular guide carries flexible glass fiber bundles which emerge at 4 to the mouth of a patient. The tubular guide can be positioned to adjust the end 4 as desired. (See column 1, lines 41-47, and FIG. 1.)

Scheer et al. are silent as to positioning the switch box 1 at another location after it has been mounted to the chair.



### Summary of Cited References

As discussed in more detail below, none of the cited references teaches or suggests, among other things, a chair or a light for a chair that includes:

- a battery housing;
- a battery housing mounted to a lower rear portion of a chair;
- a support with a light housing having a plurality of lights;
- a switch housing having a plurality of switches;
- a switch housing being spatially separated from a battery housing;
- a switch housing that is positionable with respect to a chair; and
- a switch housing with a connecting structure that enables the switch housing to be positioned as desired.

### The Present Invention

The invention is defined in independent claim 14 and depending claims 15–19, and independent claim 19 and depending 20–27 and 30. Claim 19 is discussed above.

The invention as defined in claim 14 recites a chair for use by a gaming-table employee in a casino. The chair includes a back and a light. The light includes:

- a battery housing ... mounted to the chair at ... a lower rear portion of the back of the chair;
- a support having a light housing with a plurality of lights ... [and] mounted to the chair ...; and
- a switch housing having a plurality of switches ... being spatially separated from the battery housing ... .

Dependent claims 15–19 respectively recite additional features of the chair.

### Discussion

#### Claim 14 in view of Schocket and Irminger

In contrast to the chair for a gaming table of claim 14, Schocket shows a head rest with a light for an eye exam, and Irminger shows an arm rest for a theater chair for reading programs. It is respectfully submitted that one skilled in the art would not be motivated to combine the teachings of Irminger with those of Schocket as they are incongruent and nonanalogous to the chair of claim 14. It is unclear how a plurality of lights and a plurality of switches would

actually benefit a light for an eye exam. There would be no motivation to make such a combination.

In addition to their incongruent teaching, both Schocket and Irminger fail to teach or suggest, among other things, each of the following features of the chair of claim 14:

- a battery housing;
- a battery housing mounted to a lower rear portion of a chair;
- a support with a light housing having a plurality of lights;
- a switch housing having a plurality of switches; and
- a switch housing being spatially separated from a battery housing.

Accordingly, any combination of the Schocket and Irminger patents fails to teach a suggestion of how to combine or modify the references, the combination or modification of which would appear to be sufficient to have made the claimed invention obvious to one of ordinary skill in the art. Accordingly, it is respectfully submitted that the invention as set forth in claim 14, as well as claim 15, 16, and 18 depending therefrom, would not have been obvious to one having ordinary skill in the art at the time the invention was made in view of the Schocket and Irminger patents, either alone or in combination, and that claims 14–16 and 18 are patentable.

Claim 17 in view of Schocket, Irminger, and Scheer et al.

Claim 17 depends on claim 14 discussed above, and has been amended to more particularly point out and distinctly claim the subject matter of the invention.

In contrast to the chair for a gaming table of claim 17, Schocket shows a head rest with a light for an eye exam; Irminger shows an arm rest for a theater chair for reading programs; and Scheer et al. shows a dental chair with a positionable light. It is respectfully submitted that one skilled in the art would not be motivated to combine the teachings of Scheer et al. with those of Irminger and Schocket as they are incongruent and nonanalogous to the chair of claim 17. It is unclear how the switch box of Scheer et al. would actually benefit a light for an eye exam of Schocket or the arm rest of Irminger. There would be no motivation to make such a combination.

In addition to their incongruent teaching, Schocket, Irminger, and Scheer et al. fail to teach or suggest, among other things, each of the following features of the chair of claim 17:

- a battery housing;
- a battery housing mounted to a lower rear portion of a chair;
- a support with a light housing having a plurality of lights;
- a switch housing having a plurality of switches;
- a switch housing being spatially separated from a battery housing; and
- a switch housing with a connecting structure that enables the switch housing to be positioned with respect to the chair.

As mentioned above, Scheer et al. are silent as to positioning their switch box at another location after the switch box has been mounted to the dental chair.

Accordingly, any combination of the Schocket, Irminger, and Scheer et al. patents fails to teach a suggestion of how to combine or modify the references, the combination or modification of which would appear to be sufficient to have made the claimed invention obvious to one of ordinary skill in the art. Accordingly, it is respectfully submitted that the invention as set forth in claim 17 would not have been obvious to one having ordinary skill in the art at the time the invention was made in view of the Schocket, Irminger, and Scheer et al. patents, either alone or in combination, and that claim 17 is patentable.

Claim 19 in view of Sefsik et al. and Wenegrat

As discussed above, the light for a chair of claim 19 includes:

a switch housing that is spatially separated from a light housing; and

a connecting structure that enables the switch housing to be positioned with respect to the chair.

In contrast to the light of claim 19, Sefsik et al. show a conventional chair with a conventional alegator lamp mounted thereto, and Wenegrat shows a chair with built-in lights and a switch built into the arm. Accordingly, the combination of the Sefsik et al. and Wenegrat patents fail to teach or suggest a light with a switch housing that may be positioned with respect to a chair.

Accordingly, any combination of the Sefsik et al. and Wenegrat patents fails to teach a suggestion of how to combine or modify the references, the combination or modification of which would appear to be sufficient to have made the claimed invention obvious to one of

ordinary skill in the art. Accordingly, it is respectfully submitted that the invention as set forth in claim 19, as well as claim 20 and 22 depending therefrom, would not have been obvious to one having ordinary skill in the art at the time the invention was made in view of the Sefcik et al. and Wenegrat patents, either alone or in combination, and that claims 19, 20 and 22 are patentable.

Claim 21 in view of Schocket and Irminger

Claim 21 depends from claim 19 and recites that the light housing may have a plurality of lights and that the switch housing may have a plurality of switches.

In contrast to the light for a chair of claim 19, Schocket shows a head rest with a light for an eye exam, and Irminger shows an arm rest for a theater chair for reading programs. It is respectfully submitted that one skilled in the art would not be motivated to combine the teachings of Irminger with those of Schocket as they are incongruent and nonanalogous to the light of claim 19. It is unclear how a plurality of lights and a plurality of switches would actually benefit a light for an eye exam. There would be no motivation to make such a combination.

In addition to their incongruent teaching, both Schocket and Irminger fail to teach or suggest, among other things, each of the following features of the chair of claim 14:

- a support mounted to a chair; and
- a switch housing that is positionable with respect to a chair.

Accordingly, any combination of the Schocket and Irminger patents fails to teach a suggestion of how to combine or modify the references, the combination or modification of which would appear to be sufficient to have made the claimed invention obvious to one or ordinary skill in the art. Accordingly, it is respectfully submitted that the invention as set forth in claim 14, as well as claim 15, 16, and 18 depending therefrom, would not have been obvious to one having ordinary skill in the art at the time the invention was made in view of the Schocket and Irminger patents, either alone or in combination, and that claims 14–16 and 18 are patentable.

Claim 25–27 in view of Littell

Claim 25–27 depend from claim 19 and respectively recite additional features of the light housing.

The applicant respectfully submits that it is unclear how dependent claims can be rejected for obviousness in view of a particular reference (i.e., Littell) when the base independent claim (i.e., claim 19) and any intervening claim (i.e., claim 22) are not also rejected for obviousness in view of that very same reference. Although claims 19 and 22 have been rejected for anticipation by the Littell patent, it will be assumed that the Patent Office also intended to reject claims 19 and 22 for obviousness in view of the Littell patent given the obviousness rejections of claim 25–27.

In contrast to the light for a chair of claim 19 in which a switch housing is both spatially separated from a light housing and includes a connecting structure that enables the switch housing to be positionable with respect to a chair, Littell shows a chair with a conventional alegator lamp mounted thereto. Littell's lamp has a switch located at the light. Accordingly, the switch is not spatially separated from the light and does not include a connecting structure for enabling independent positioning with respect to the chair.

Accordingly, the Littell patent fails to teach a suggestion of how to modify the reference, the modification of which would appear to be sufficient to have made the claimed invention obvious to one of ordinary skill in the art. Accordingly, it is respectfully submitted that the invention as set forth in claim 19, as well as claim 22 and 25–27 depending therefrom, would not have been obvious to one having ordinary skill in the art at the time the invention was made in view of the Littell patent and that claims 19, 22, and 25–27 are patentable.

Claim 30 in view of Schocket and Scheer et al.

Claim 30 depends on claim 19 and respectively recites that the switch housing is positionable with respect to the light housing.

In contrast to the light for a chair of claim 30 in which a switch housing is both spatially separated from a light housing and includes a connecting structure that enables the switch housing to be positionable with respect to a chair, Schocket shows a head rest with a light for an eye exam, and Scheer et al. shows a switch box fixed to a chair at a desired location. Scheer et al. are silent as to positioning the switch box with respect to the chair after mounting. It is respectfully submitted that one skilled in the art would not be motivated to combine the teachings of Schocket and Scheer et al. as the teachings are incongruent and nonanalogous and as there is no clear benefit from the combination.

Accordingly, any combination of the Schocket and Scheer et al. patents fails to teach a suggestion of how to combine or modify the references, the combination or modification of which would appear to be sufficient to have made the claimed invention obvious to one of ordinary skill in the art. Accordingly, it is respectfully submitted that the invention as set forth in claim 30 would not have been obvious to one having ordinary skill in the art at the time the invention was made in view of the Schocket and Scheer et al. patents, either alone or in combination, and that claim 30 is patentable.

Claim 30 in view of Littell and Scheer et al.

Claim 30 depends on claim 19 and respectively recites that the switch housing is positionable with respect to the light housing.

In contrast to the light for a chair of claim 30 in which a switch housing is both spatially separated from a light housing and includes a connecting structure that enables the switch housing to be positionable with respect to a chair, Littell shows a chair with a conventional alegator lamp mounted thereto, and Scheer et al. shows a switch box mounted (i.e., fixed) to a chair at a desired location. Scheer et al. are silent as to positioning the switch box with respect to the chair after mounting.

Accordingly, any combination of the Littell and Scheer et al. patents fails to teach a suggestion of how to combine or modify the references, the combination or modification of which would appear to be sufficient to have made the claimed invention obvious to one of ordinary skill in the art. Accordingly, it is respectfully submitted that the invention as set forth in claim 30 would not have been obvious to one having ordinary skill in the art at the time the invention was made in view of the Littell and Scheer et al. patents, either alone or in combination, and that claim 30 is patentable.

**ALLOWABLE CLAIMS**

Claims 1–13 have been deemed allowable if amended to overcome the objections set forth in the Office Action, and claims 28 and 29 have been objected to as being dependent on a rejected base claim. The Examiner is thanked for indicating the allowability of claims 1–13, 28, and 29.

Claims 1 and 7 have been amended as discussed above. It is respectfully submitted that claims 1-13 are now in condition for allowance.

Applicant at this time has not rewritten claim 28 in independent form because of the belief that the base claim, i.e., claim 14 is patentable and in condition for allowance. However, if the Patent Office issues a final rejection on claim 14, then the applicant will final an amendment after final to place claims 28 and 29 in condition for allowance.

#### CLOSING REMARKS

It is respectfully submitted that the subject application, including claims 1-30, is in condition for allowance. Confirmation of the allowance is respectfully requested.

The Examiner is invited to contact the undersigned at the telephone number below to discuss any issue that may remain, preventing the allowance of the application.

Respectfully submitted,

Dated: October 6, 2004



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Eric K. Satermo  
Registration No. 40,195

17744 Skypark Circle, Suite 295  
Irvine, California 92614  
Telephone: (949) 752-9525  
Facsimile: (949) 752-5585